

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-3 and 5-9 remain in the application. Claims 1, 5, 7, and 8 have been amended. Claim 4 is being cancelled herewith.

In item 3 on page 7 of the above-identified Office action, claims 7 and 8 have been rejected as being indefinite under 35 U.S.C. § 112.

Claims 7 and 8 have been amended so as to facilitate prosecution of the application. Therefore, the rejection has been overcome.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

In item 5 on page 3 of the above-identified Office action, claims 1-3 and 9 have been rejected as being fully anticipated by Graf (U.S. Patent No. 4,418,256) under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and as a whole, the claims have, therefore, not been amended to overcome the references. However, in order to facilitate prosecution of the application, claims 1 and 5 have been amended so as to include the subject matter of claim 4.

As noted above claim 1 has been amended to include the subject matter of claim 4. Claim 4 was not rejected over the Graf reference. Therefore, claim 1 is allowable over Graf. Since claim 1 is allowable over Graf, dependent claims 2, 3, and 9 are allowable over Graf as well.

In item 6 on page 4 of the Office action, claims 1, 2, 5, and 6 have been rejected as being fully anticipated by Dreyfuss (U.S. Patent No. 3,486,931) under 35 U.S.C. § 102.

As noted above, claims 1 and 5 have been amended to include the subject matter of claim 4. Claim 4 was not rejected over the Dreyfuss reference. Therefore, claims 1 and 5 are

allowable over Dreyfuss. Since claims 1 and 5 are allowable over Dreyfuss, dependent claims 2 and 6 are allowable over Dreyfuss as well.

In item 8 on page 6 of the above-identified Office action, claims 1-4 and 9 have been rejected as being fully anticipated by Zielke (WO 99/65128) under 35 U.S.C. § 102 or in the alternative as obvious over Zielke (WO 99/65128) under 35 U.S.C. §103.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

a mixture of first granules and second granules, the first granules defining first subvolumes and the second granules defining second subvolumes, the subvolumes being made of PTFE, the first granules having an increased electrical conductivity with respect to the second granules.

It is once again noted that the corporate assignee of the Zielke reference is also the assignee of the instant application. Furthermore, Mr. Zielke is the sole inventor of

the reference and the instant application. Therefore, applicant is very familiar with the Zielke reference.

It is noted that the remarks made with respect to the Zielke reference in the previous response are still valid and are incorporated herein by reference in their entirety.

On pages 6-7 of the Office action the Examiner alleges that "the Examiner notes the following product-by-process limitation: the requirement in applicant's claims 1 that the part is made from mixing first and second granules, wherein said first granules have an increased electrical conductivity."

It is respectfully noted that the Examiner's allegation is in error. Particularly, the limitation is in no way a product-by-process limitation. Specifically, the claim recites that the insulating piece is a mixture of first granules and second granules. This is explicitly shown in Fig. 1 of the instant application which designates the treated subvolumes 3 and the untreated subvolumes 4. Claim 1 does not recite a mixing of first granules and second granules. Claim 1 only recites a mixture of the first granules and second granules. A mixture is a physical property and not a process step. Therefore,

claim 1 does not recite a product-by-process limitation.

Accordingly, it is respectfully noted that the Examiner's allegation with respect to a process-by-product limitation, is not accurate.

Furthermore, because claim 1 is not a product-by-process limitation, it is respectfully noted that the Examiner's further allegations pertaining to product-by -process limitations (especially those allegations made in the first paragraph on page 9 of the Office action), are not applicable to the product claims.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The reference does not show or suggest a mixture of first granules and second granules, the first granules defining first subvolumes and the second granules defining second subvolumes, the subvolumes being made of PTFE, the first granules having an increased electrical conductivity with respect to the second granules, as recited in claim 1 of the instant application. The Zielke reference discloses that surface areas of an insulating material are treated with

radiation. Zielke does not disclose that the insulating component is a mixture of first and second granules, where the first granules have a higher conductivity than the second granules. This is contrary to the invention of the instant application as claimed, which recites a mixture of first granules and second granules, the first granules defining first subvolumes and the second granules defining second subvolumes, the subvolumes being made of PTFE, the first granules having an increased electrical conductivity with respect to the second granules.

The reference applied by the Examiner does not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, with respect to the Examiner's allegations on page 12 of the Office action with respect to product-by-process limitations, as noted above, claim 1 does not recite a product-by-process limitation. Therefore, the Examiner's allegations are not accurate.

Moreover, the on page 12 of the Office action the Examiner alleges that "it is the Examiner's position that the arguments

provided by the applicant regarding Zielke (WO 99/65128) must be supported by a declaration or affidavit."

It is respectfully noted that the Examiner appears to ignore the specification of the instant application. The Examiner is kindly requested to review pages 1-4 of the specification, which are more than ample to support "the arguments of counsel" and which provide sufficient evidence. Furthermore, the Examiner is reminded that the application was submitted with a declaration by Applicant. Therefore, assurance is provided that the statements and representations made are correct.

As seen from the above-given remarks, claim 1 is allowable over Zielke. Since claim 1 is allowable over Zielke, dependent claims 2-4 and 9 are allowable over Zielke as well.

In item 10 on page 9 of the Office action, claims 1-4 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of Zielke (U.S. Patent No. 6,627,831).

On page 10 of the Office action the Examiner alleges that "the Examiner has reason to believe that the insulating part of

Zielke inherently comprises treated subvolumes (<50% in amount compared to the total amount of treated and untreated subvolumes) in the untreated subvolumes"

It is respectfully noted that the Examiner has not met the requirement to show inherency. Particularly, MPEP § 2112 (8th edition, 1st revision) states that:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

As discussed in MPEP § 2112, a limitation recited in a claim that is not expressly or implicitly disclosed in a prior art reference is inherently disclosed therein if, and only if, the "missing" limitation is **necessarily present** in the prior art, and that it would be so **recognized by persons of ordinary**

skill. The principles of inherency require that the inherency be **absolute**, and not probabilistic. As far as applicants were able to ascertain, there is no disclosure or suggestion in Zielke that it is **absolutely necessary** that the insulating component comprises treated subvolumes embedded in the untreated subvolumes.

Furthermore, according to a sub-heading in MPEP § 2112, the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", i.e. the Examiner has the burden of proof (by a preponderance of the evidence) to show that Zielke **necessarily** disclose or suggest purposefully the insulating component comprises treated subvolumes embedded in the untreated subvolumes. Instead of offering factual evidence disclosing or suggesting the insulated device comprises treated subvolumes embedded in the untreated subvolumes, in the context of the present invention, the Examiner made a statement without any factual support or *Official Notice*. The Examiner cannot simply be the devil's advocate postulating certain results or processes that may or may not occur or be present in the applied prior art and leave it up to Applicants to show or prove the contrary. Furthermore, it is respectfully noted that the language of "has reason to

believe" is nowhere close to meeting the requirements of inherency.

Accordingly, it is respectfully noted that the Examiner's allegation does not meet the requirement to show inherency.

As noted above, the reference does not show or suggest a mixture of first granules and second granules, the first granules defining first subvolumes and the second granules defining second subvolumes, the subvolumes being made of PTFE, the first granules having an increased electrical conductivity with respect to the second granules, as recited in claim 1 of the instant application. The Zielke reference discloses that surface areas of an insulating material are treated with radiation. Zielke does not disclose that the insulating component is a mixture of first and second granules, where the first granules have a higher conductivity than the second granules. This is contrary to the invention of the instant application as claimed, which recites a mixture of first granules and second granules, the first granules defining first subvolumes and the second granules defining second subvolumes, the subvolumes being made of PTFE, the first granules having an increased electrical conductivity with respect to the second granules.

The reference applied by the Examiner does not teach or suggest all the claim limitations. Therefore, the obviousness-type double patenting rejection is misplaced.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 5. Claims 1 and 5 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 5, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-3 and 5-9 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,

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